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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,699	12/07/2001	Larry Scites		5727

7590 10/05/2004

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,699

Applicant(s)

SCITES, LARRY

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Status***

Claims 1-20 are pending and are treated in this office action.

### ***Claim Rejections - 35 USC § 112***

1. **Claims 16-20 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 16, the phrase "Means for avoiding direct representation ...transactions" is vague and indefinite.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-9 (method<sup>1</sup>), 10-15 (method<sup>2</sup>), 16-20 (apparatus<sup>1</sup>) are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of CANNEY (US 6,581,041).**

**As for independent method claim 1**, AAPA, as shown in the "Background of the invention" from pages 1-3, fairly teaches the claimed invention except for the last step of:

(c ) paying at least a 20% portion of a broker referral fee received by the real estate (RE) management system to a charity chosen by the RE customer.

Note this also fairly matches applicant's goal, as shown on page 4 [07], "the present invention is directed to diverting RE commission money away from RE professionals to charity organization. As for the limitation of "a real estate referral management system (RERMS), the referral business is fairly taught in pages 2-3 especially page 3, [06] "a real estate industry to the referral fee system". The set up of a management system to efficiently manage a referral system would have been obvious to improve system efficiency especially when dealing with other abnormal agency if desired and is within the skill of an artisan. Note that on page 3, it teaches that it's well known/accepted that in every city in the US, RE companies now actually compete for the privilege of paying this 30% referral fee and on page 2, referral amount typically being on the order of 25% to 30% of commission earned.

In a method of charitable giving/business servicing, CANNEY fairly teaches a method whereby a customer can (1) help charity and (2) saving on taxes by having an agreement with Broker to divert a portion of the fee or commission for service rendered on the customer to charity chosen by the customer (see col. 3, lines 1-10 (or c3:1-10), c5:1-10, 35-40). Note that CANNEY teaches that this concept can be applied to brokerage that charges a commission than a fee or any account that charges a fee. The type of account is not a limiting factor (c5:10-15) or can be used with other types of business transaction (i.e. investment) and different types of business service (account) (see c4:55-65). Also, in c5:42-50, the teachings are used in generic and descriptive sense only and not for purpose of limitation and changes in one or more steps are contemplated without departing from the scope of the invention.

It would have been obvious to a skilled artisan to modify the teaching of AAPA by carrying out step (c ) as taught by CANNEY above to allow customer to (1) help charity and (2) saving on taxes. As for the limitation of at least 20% of fee to charity, it's known that the referral fee is about 30%, the selection of at least 20% falls within about 30% and this depends on the generosity and tax benefits of the business in charge and customer. As for the difference between the business service, financial service vs. real estate service which also include financial transaction, this is not critical for all of the reasons mentioned above. Moreover, the applying of the same generic concept of "diverting fee/commission money away from business to charitable organization", which is the same as in the claimed invention (see page 4), to other similar business service or transaction would have been obvious to a skilled artisan to obtain similar results, absent evidence of unexpected results. No unexpected results between the type of business have been shown.

**As for dep. claims 2-3 (part of 1),** the limitations of agreement of the diversion of fee between the parties would have been obvious and/or reasonable to a skilled artisan to allow smooth transaction before any service can be carried out to avoid disagreement later on, absent evidence of unexpected results. Notice that this practice is similar to well known "rebate" practice wherein all parties in the transaction are informed in writing before the time the offer to purchase is signed.

**As for dep. claim 4 (part of 1),** which deals with the set up of the RERMS in the transaction, this is non-essential to the scope of the claimed invention and would have been to a skilled artisan to do so to enhance the perception of being fair/impartial to all

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parties especially with charity organization and present no competition to the buyer/seller brokers, absent evidence of unexpected results.

**As for dep. claim 5** (part of 1), which deals with another marketing strategy for RERMS to connect with other business, this is non-essential to the scope of the claimed invention and would have been to a skilled artisan to do so to improve marketing strategies to facilitate the fund raising campaign.

**As for dep. claim 6** (part of 1), which deals tax record/reporting between the donor and the charity, this is non-essential to the scope of the claimed invention and is fairly taught in CANNEY c5:35-45.

**As for dep. claims 7-8** (part of 1), which deals associating with a 3<sup>rd</sup> party that does not have a RE broker's license, such as Charity organization, this is fairly taught in CANNEY on c4:1-30, "charitable organization, church, foundation, etc. ".

**As for dep. claim 9** (part of 1), which deals with the connection of all parties, except for the customer, to improve business integrity, i.e. member of the National Association of Realtors (NAR), this is non-essential to the claimed invention and would have been obvious to do so to ensure compliance to the contract/agreement for fee diversion since a code of ethics for the NAR to require its members to abide by contract/agreement with other brokers to maintain good standing membership and member's business integrity and reputation.

Alternatively, the various minor changes in the dependent claims above are considered as optimizing operating conditions or result effective variables (i.e, set up of RERMS, other marketing strategy, type of 3<sup>rd</sup> party, improving business integrity, etc.)

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and the optimizing of result effective variables is considered as routine experimentation to determine optimum or economically feasible reaction conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. In re Aller, 105 USPQ 233.

4. **As for Independent method claim 10**, which has similar limitations as in claim 1 and 2, it's rejected for the same reason set forth in claim 1 and 2 above.

**As for dep. claims 11-14 (part of 10)**, which have similar limitations to dep. claims 6, 7, 5, 8, and 9, respectively, they are rejected for the same reasons set forth in claims 6, 7, 5, and 8 above.

5. **As for Independent Apparatus claim 16**, which has similar limitations as in independent method claim 1 and 4, it's rejected for the same reason set forth in claim 1 and 4 above in view of the fact the step of doing something would require a means for carrying the step. Alternatively, it would have been obvious to a skilled artisan to set up a means for carrying out the step. For example, pumping water would require a pump to pump the water.

**As for dep. claims 17-20 (part of 16)**, which have similar limitations to claims 9, 2, 1 (part c), and 3, respectively, they are rejected for the same reasons set forth in those respective claims above.

No claims are allowed.

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6. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov) .


Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
October 4, 2004

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**